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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND F. RATCLIFF III

Appeal 2007-1302
Application 09/818,003
Technology Center 2100

Oral Hearing Held: May 9, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON, and JEAN R. HOMERE, Administrative Patent Judges.

ON BEHALF OF THE APPELLANT:

DALE LAZAR, ESQ.
DLA PIPER US LLP
P.O. Box 9271
Reston, VA 20195

The above-entitled matter came on for hearing on Wednesday, May 9, 2007, commencing at 9:08 a.m., at The U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

JUDGE THOMAS: Good morning.

MR. LAZAR: Good morning.

JUDGE THOMAS: You've been here before, haven't you?

MR. LAZAR: Well, I have. Not recently though, not since the move to the new building.

JUDGE THOMAS: The rules are basically the same, you know. You have 20 minutes. You can use that clock as a guide.

MR. LAZAR: Okay, great.

JUDGE THOMAS: You may proceed at any time.

MR. LAZAR: Okay. Thank you very much. May it please the board, my name is Dale Lazar. I'm here on behalf of the inventor, Raymond Radcliff and the owner of this application, Hemisphere II.

Well, first, I guess, you hear a lot of this. We're in a post-KSR world with pre-KSR briefs. If I had a dollar for every time I mention suggestion, teaching or motivation in the brief, I think I'd be able to retire at this point. If you could read the word -- reason for suggestion, teaching or motivation in our briefs, I think the result comes out to the same whether we're talking pre-KSR or post. I think our invention is clearly patentable, and I hope to be able to establish that for you this morning.

The invention relates to a system for identifying a document. You're on a train reading a newspaper, you're in a library reading an article or a magazine somewhere and it's interesting to you and you think that it would be interesting to someone else.

How do you get that article to that other person? Well, you could tear out that article and physically get it to them, but that may not be a practical solution. You could scan the entire article with some sort of scanner and

send an electronic version of the article to the person you wish to have it be received by. But that is cumbersome if you're doing hand scanning. That's not such a great solution.

What Mr. Radcliff has come up with is a kind of a hybrid solution to this problem. What Mr. Radcliff suggests is that you do capture an image of at least a part of the document and you use that actual data from the document itself as an identifier of the document that can be sent to a computer or a server somewhere to actually represent the document.

Then that computer or server would compare the snippet of the article whose image was captured with the database and look for that article in the electronic database. And then that electronic article from the database could be sent to the intended recipient in a much higher form than would be the case if you actually just scanned the whole document.

So that's the essence of the invention.

We can start with Claim 1. Claim 1 of the application talks about a method for sending information to a data processing system for identification of a document. The body of the claim talks about providing the document and capturing information from the document where the information comprises actual data from the document.

So somehow we're capturing data from the document, either by scanning maybe the title of the document and the date or the journal cite for it or the first few lines of the document, or perhaps using a digital camera to capture that information, somehow capturing information about the document where that information comprises actual data from the document. That's an important limitation.

Storing the captured information, establishing a communication path, retrieving the document from the memory of the handheld device and then sending the retrieved information to the data processing apparatus through the communications path for identification of the document.

So we're using -- we're capturing with a handheld device actual data from the document and using that to identify the document. This claim, Claim 1, was rejected over the combination of a patent to Eldridge and a patent to Neukermans.

Eldridge talks about a data processing system that employs tokens to reference a document or a server. Well, what's a token? A token, according to Eldridge, is or contains information about an operation to be performed, the address of the document, parameters, defining the property of the document, perhaps the visible name of the document, and then security parameters.

The idea here is that if you send tokens through the system rather than the document itself to cut down on the volume of data that needs to be transmitted. So if a computer wants to -- if a command comes to a computer to have a document printed, that computer would generate a token and the token would be sent to the printer.

The printer would look at the token and understand that it is to print three copies of this document, for example. It would know the identity of the document and where to retrieve the document from. There would be security parameters also to make sure that all of this happens in a secured, controlled sort of environment. And then the printer would do what it was told to do in accordance with the token.

The examiner agrees that Eldridge never contemplated the idea of including actual data from the document itself in the token, okay.

JUDGE THOMAS: Let's clarify something. The only feature of Claim 1 that's not in Eldridge allegedly by the examiner is the capture capability?

MR. LAZAR: It's two things. Well, I think the examiner would -- hard to say what the examiner would think, but from my perspective anyway, Eldridge does not suggest capturing actual data from the document itself. And then I think the examiner would agree that Eldridge does not teach using that actual data to identify the document. It goes hand in hand.

JUDGE HOMERE: I'm trying to figure out what this -- capturing information from the document, what that actual entails. It appears to me -- I guess maybe I should put the question to you. Would capturing the information from the document be something that for instance, you're reading the newspaper and then you write down on a piece of paper, you write down or copy a portion of it and then you key it into for instance your telephone functions, your mobile phone. Would that be capturing?

MR. LAZAR: Not in the context of this invention and the claim. This requires a handheld device.

MR. HOMERE: But the claim doesn't say that you're capturing the information using the handheld device, does it?

MR. LAZAR: In the preamble it does, yes, using a handheld device capable of communication with the data processing apparatus and then storing the captured information in the handheld device as document data.

JUDGE HOMERE: -- the method for sending information using the handheld device, but it doesn't say that you're actually capturing information

using the handheld device. So any way you can capture that information would do based on what I'm seeing here, right?

MR. LAZAR: Yes, I suppose that's right.

JUDGE HOMERE: Okay. Thanks.

MR. LAZAR: I suppose that's right. It's not what was intended, but I think you're right.

JUDGE HOMERE: Okay. Thanks.

JUDGE THOMAS: So if there's a teaching in Eldridge that suggests that the capturing capability otherwise was already done somewhere else, is it your admission now that the capturing feature of the claim would have been taught by Eldridge?

MR. LAZAR: No. No, because there's no suggestion in Eldridge -- first of all there's no suggestion of including this captured information as an identifier of the document.

JUDGE THOMAS: So that's another feature?

MR. LAZAR: Well, right. I think we're saying the same thing over and over again, but I would say it's the same feature.

JUDGE THOMAS: So the real definitive feature that you're arguing is the wherein clause of the information comprising actual data from the document?

MR. LAZAR: That, coupled with that "actual data being used to identify the document at the very end of Claim 1."

JUDGE THOMAS: Okay.

MR. LAZAR: And I think the telling part of Eldridge is at column one, lines 35 through 37 where it says that "documents are effectively distributed by tokens rather than the lengthy document itself." The whole

point of Eldridge is to get rid of the document, to transmit tokens through the system rather than the document itself.

Neukermans is just a hand scanner. It's a device capable of scanning and storing a document. And we acknowledge that certainly we weren't the first to scan documents by hand.

JUDGE HOMERE: Let me suggest something to you for a moment. You say that the primary reference is the tokens. You get a piece of token and then you send information -- which you use to send information to the printer, right?

MR. LAZAR: Correct.

JUDGE HOMERE: And you get to the printer to technically print something out, right? Okay. Now would it not be reasonable to construe that the token itself has information about something?

MR. LAZAR: It has information about the document, no question. It has identifying information.

JUDGE HOMERE: Exactly, yes. Now how the information gets into the token we don't know. Now couldn't that be construed as information that's embodied that's stored in the token as information that has been captured?

MR. LAZAR: No. At least there's no suggestion of that in Eldridge. If you read Eldridge from stem to stern, Eldridge identifies five things as being in --

JUDGE HOMERE: No, no. What I'm saying -- I'm looking at this from the standpoint of one -- I'm saying that you have a token, right? And the token itself has information that you're going to be forwarding to a printer in order for the printer to print something, right?

MR. LAZAR: Right.

JUDGE HOMERE: So I'm saying that since the token itself has information in it, therefore that information must have been captured somehow. Someone might have put it in there, because the claim doesn't say that you're actually using the handheld device to capture it and put it in a token. So somehow you got the information in the token, right?

MR. LAZAR: But the information in the token is not captured from the document itself.

JUDGE HOMERE: It's captured from a document?

MR. LAZAR: It is identifying information that identifies the document.

JUDGE HOMERE: -- a document, right?

MR. LAZAR: The document, yes, a document, and where it's stored.

JUDGE HOMERE: And therefore that information -- what is it?

MR. LAZAR: And where it's stored.

JUDGE HOMERE: Yes, therefore that information must have been captured in order for it to be in the token.

MR. LAZAR: But not from the document itself. It isn't actually data from the document. It's abstracted from the document perhaps, but it isn't the document itself.

JUDGE HOMERE: But the claim does not require that their document itself be captured. It requires that information from the document --

MR. LAZAR: No, actual data from the document is the information, actual data from the document.

JUDGE HOMERE: Yes, but it doesn't have to be the whole document. It only requires a portion of the document. It could be the data, right? So for all that we know the token itself could be just the page, if we're going to relate it to a page in the document to be printed out.

MR. LAZAR: I agree that it doesn't have to be the entire document.

JUDGE HOMERE: Oh, all right.

JUDGE THOMAS: So what's the scope of teaching in Eldridge of token?

MR. LAZAR: The whole point of the token in Eldridge is to eliminate the actual document, as suggesting in column one of Eldridge.

JUDGE THOMAS: Well, I'm asking for you to tell me what you think Eldridge teaches as to what is a token.

MR. LAZAR: Eldridge teaches --

JUDGE THOMAS: Can Eldridge's token be a part or any label derived from information on the document itself like a whole page or a title or a publisher or a cite from like the Washington Post, you know, that gives you the date and the edition and all that stuff?

MR. LAZAR: No suggestion of that in Eldridge. You wouldn't, of ordinary skill in the art, reading Eldridge you would not understand that. Eldridge limits the token to the five things that I've previously mentioned, none of which you've mentioned.

JUDGE THOMAS: What are the five things again, please?

MR. LAZAR: The operation to be performed on the document, the address of the document in the data processing system, a parameter defining a property of the document, the visible name and security parameters.

Our view is that it wouldn't be obvious to combine Neukermans with Eldridge. There is a teaching away here. The whole point Eldridge teaches us that the system -- that Eldridge wants the system to transfer tokens around the system to avoid the lengthy document itself.

JUDGE THOMAS: Do you argue teaching away in the briefs?

MR. LAZAR: Yes.

JUDGE THOMAS: Okay.

MR. LAZAR: Yes, whereas Neukermans is intended to capture the entire document itself and store the document itself and transmit the document itself.

JUDGE THOMAS: So what happens if Neukermans is a good reference by itself to reach Claim 1?

MR. LAZAR: Neukermans has nothing to do with identifying the document. You've captured the document itself. There's no suggestion of a database. There's no suggestion of sending that information to identify the document.

JUDGE THOMAS: Well, let's -- is that the only distinction that you feel Neukermans has as to Claim 1?

MR. LAZAR: As to Claim 1.

JUDGE THOMAS: All right. The preamble talks about for identification of the document, does it not?

MR. LAZAR: Yes.

JUDGE THOMAS: And so does the last few words of the claim, right?

MR. LAZAR: Right.

JUDGE THOMAS: But there's no stated step that does the ID in the claim?

MR. LAZAR: That is true. We're sending it for identification though.

JUDGE THOMAS: So how are we supposed to treat those words? For identification is the desired end result for which there's no recited step that achieves it.

MR. LAZAR: Well, the sending -- that's a good point. Claim 12 overcomes that by also requiring the steps of comparing the scanned information, the actual data from the document with documents in the database and selecting one of the documents in the database that makes the scanned data.

JUDGE THOMAS: So are you going to still maintain that Claim 1 is patentable on Neukermans alone?

MR. LAZAR: Yes, because I think that the sending step is for the specific purpose of identifying the document, and that is not done in Neukermans or Eldridge for that matter. So that's really the heart of the argument.

The client, the invention --

JUDGE THOMAS: I'll give you some more time. Just don't worry about the clock, okay.

MR. LAZAR: The heart of the -- the essence here is that we're capturing actually data from the document that's used to identify that document.

JUDGE THOMAS: And that's the major theme of your arguments?

MR. LAZAR: Right. You have Eldridge and Neukermans, which point in different directions in terms of a teaching away sort of thing where

you have Eldridge saying in the patent itself that the point of the tokens is to avoid the lengthy document whereas Neukermans captures the lengthy document.

It wouldn't be obvious to put those together. Even if you did, you still aren't creating a system that captures actual data from the document to identify that document. Neukermans captures the document to be the document rather than to identify the document.

JUDGE HOMERE: Counselor, you said that one of the five things that the token can hold is parameters of the document?

MR. LAZAR: Yes. Rather undefined in Eldridge as to what those parameters are, but it's --

JUDGE HOMERE: So it's parameters, the location of the document -- parameters, location of document and what were the other three?

MR. LAZAR: Operation to be performed.

JUDGE HOMERE: Okay.

MR. LAZAR: The name and the security parameters.

JUDGE HOMERE: Okay. Let's stick with the parameters and the name of the document. Would the name of the document itself be data, actual data from the document? Can that be construed as actual data from the document?

Like say for instance you have a newspaper article entitled KSR Versus Deltaflex, for instance, and then somehow in the token itself you get that information in there, could that be construed as -- because it says that one of the types of information it can include in the token is the name of the

document. Could that be construed as actual data from the document that's being sent to the burner?

MR. LAZAR: The visible name is abstracted from the article, but whether that visible name matches anything that actually is in the document itself is up to the abstracter. It depends on what you want to put into the token. It does not necessarily need to be what is actually in the document itself.

JEAN HOMERE: Yes, but the name of the document could be the title of the document, for instance, as you said.

MR. LAZAR: It could be, but it doesn't have to be. It's not captured from the document itself; it's whatever the abstracter wants to put into the token.

JUDGE HOMERE: Why does it appear to me that Eldridge by itself appears to teach all the -- limitations of Claim 1, this another interpretation of what the token is doing?

MR. LAZAR: Because Eldridge doesn't teach capturing that information from the actual data of the document itself.

JUDGE HOMERE: Not withstanding the fact that it teaches a token -- include the name, the name of the document?

MR. LAZAR: That may or may not be from the document itself. It may be completely made up the abstracter.

JUDGE HOMERE: Okay.

JUDGE THOMAS: To the extent it is the actual name of the document done by the abstracter how do you see that?

MR. LAZAR: There's no requirement in Eldridge that it has to be there. You're putting more into Eldridge than what's there. This token is

not -- is created by whoever is operating the system, if not done electronically by the system itself.

JUDGE THOMAS: Well, how is the ordinary skilled person going to view that teaching about Eldridge?

MR. LAZAR: I think that person would not -- would realize and the examiner accepts the fact that the token in Eldridge does not include actual data from the document itself.

JUDGE HOMERE: So you're saying that when I was -- I would have not known that a name is -- can be construed as a title, for instance, of a document?

MR. LAZAR: It can be, but there's no requirement is Eldridge that it does be, if you will.

JUDGE HOMERE: Yes, but I'm saying, but for one skilled in the art, having that information before them, would that person readily recognize that, well, you know, I have a title before me or I have a name of a document before me, then that information is -- the name is the same thing as the title, therefore, you know, that's from the document, therefore it's actual data from the document.

MR. LAZAR: But there's no requirement that that title come or the name come from the document itself. It can be a name given to the document by the system creator.

JUDGE DIXON: Does that matter?

MR. LAZAR: Yes, I think it does matter.

JUDGE DIXON: We have a method here with a sequence of steps and if in one of those situations the sequence of steps is met the claim is met. It doesn't need to do it in all situations. You haven't recited a machine which

is doing this and has to do it all the time. You have a sequence of steps that are met, and if that meets it, the claim is met under 102.

I mean yes, you can say it's not taken from the specific document. If somebody reads it and they type it in, it is there. Providing a document they have at that point captured the information from the document, put it in their hand, typed it in wherein the information comprised actual data from the document -- you didn't say you scanned it.

If you did, his interpretation is out, then unless then you're going to say that the person had to scan it, which arguably -- one skilled in the art -- a scanner would do that also. But it meets the claim limitations. I understand your situation. It doesn't do it in all. You don't have 'all' in there. One situation meets it; arguably you've got a 102.

It seems like under either reference according to the two judges --

MR. LAZAR: I understand what you're saying.

JUDGE DIXON: Maybe Claim 12 is a better claim to differentiate, but --

MR. LAZAR: Well, Claim 12 certainly does and Claim 16 even goes farther than Claim 12 in differentiating from these references.

I, to be perfectly honest, have been operating under the believe that the capturing was by the handheld device. I see what you're saying about the fact that it isn't. It would certainly make the case stronger if --

JUDGE DIXON: Or if it was structured as an apparatus claim doing the method somehow, yes inferentially maybe you could interpret it that way. Here it doesn't seem like it's an unreasonable interpretation.

If it meets it in one step, one interpretation, granted, yes, there are other interpretations, but we don't have to meet it all, we have to meet it once.

MR. LAZAR: If you look at the preamble though, the preamble talks about a method of sending information to a data processes system for identification of a document.

JUDGE DIXON: That's the sending, and it would do that.

MR. LAZAR: Right.

JUDGE DIXON: Once you put it in it would be sent.

MR. LAZAR: Right.

JUDGE DIXON: It was from the document, but it was captured in a different manner.

MR. LAZAR: having the information -- a document having the information. Using a handheld device --

JUDGE THOMAS: The sending function is by using.

MR. LAZAR: I see what you're saying.

JUDGE THOMAS: Are you ready to concede patentability of Claim 1?

MR. LAZAR: No. I don't think so. I still stand by the fact that the capturing of the actual data from the document is something that is not taught in Eldridge. The examiner and we are in agreement on that.

JUDGE DIXON: But you wouldn't have heartburn if we were to make our own finding?

MR. LAZAR: Well, I certainly would know how to fix Claim 1 to make your finding more challenging.

MR. HOMERE: Do you have anything else?

MR. LAZAR: No, that's it. Claim 12 gets into comparing and selecting. Claim 16, then, you actually provide an address of the information of the recipient to receive the information, and once you select the document out of the database you then send the document, the actual electronic document to the intended recipient using the address information moving further and further away from Eldridge and Neukermans.

JUDGE HOMERE: Thank you very much.

MR. LAZAR: Okay. Thank you very much.

JUDGE HOMERE: Thank you.

JUDGE THOMAS: Have a good day.

(Whereupon, the proceedings concluded.)